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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,912

09/22/2006

Siegfried Ellmann

3850

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7590

12/03/2009

MICHAEL J. STRIKER
103 EAST NECK ROAD
HUNTINGTON, NY 11743

EXAMINER

NGUYEN, CUONG H

ART UNIT

PAPER NUMBER

3661

NOTIFICATION DATE

DELIVERY MODE

12/03/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

striker@strikerlaw.com

Office Action Summary	Application No. 10/593,912	Applicant(s) ELLMANN ET AL.	
	Examiner CUONG H. NGUYEN	Art Unit 3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/18/09 (an IDS).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-14 is/are objected to.
- 8) ☒ Claim(s) 2-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. This Office Action is the answer to an IDS filed on 11/18/09, and a preliminary amendment received on 9/22/2006.
2. Claims 1-14 are pending in this application.

Priority

3. Applicants claim a Germany priority of 3/26/2004 (for 10 2004 015 496.1).

Information Disclosure Statement

4. An IDS filed on 11/18/2009 is considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kim (US Pat. 6,029,104).

Kim teaches all claimed structural components for a device that is movable along a guide way/a track (ref.10) vehicle (see Kim, the abstract), comprising:

- **data transmitters** disposed along a rail-way and provided with data vehicle (see Kim, col. 2 lines 64-65);
- **data acquisition units** mounted on a vehicle and used for scanning the data form those transmitters (i.e., see Kim, laser bar-code scanners refs. 60a-60b);

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- an evaluation device (i.e., a computer to receive signals then processing those received signals) connected to said data acquisition units for evaluating the data signals (i.e., laser bar-code scanners) connected to the evaluation device (i.e., a computer) and that the evaluation device (i.e., a computer) has an output for controlling a vehicle – this is inherently in magnet levitation/rapid transit controlled trains (see Kim, col. 2 line 45 to col. 3 line 12, and Figs. 1-6). Therefore, Kim teaches all claimed limitations.

Election/Restrictions

6. This application contains claims directed to the following patentably distinct species of the claimed invention:

Claims 3 and 5 are split from a device claim 1 to comprise different transmitters (that providing different kinds of data):

A. Species I (embodiment 1): Claim 3's limitation requires a data transmitter comprise position transmitters provided with absolute location data.

B. Species II (embodiment 2): Claim 5's limitation requires a data transmitter comprise position transmitters provided with relative location data.

The applicants are request to select OR modify claim(s) (to select species I, II for examination) so that a unique species/claims is defined according to a unique invention.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable (currently, a generic claim 1 is rejected on Kim as shown above in section 5).

Applicants are advised that a reply to this requirement must include an identification of the group that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicants traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

7. Claims 1 is not patentable, claims 2-14 are objected in this office action.

Claims 3, 5 are required a restriction.

8. Note: Pending claims are directed to a device comprising physical components; therefore, a claimed device must be distinguished from the prior art in terms of structure rather than function, see *in re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim

containing a "recitation with respect to the manner in which a claimed apparatus/device is intended to be employed does not differentiate the claimed apparatus/device from a prior art apparatus/device if the prior art apparatus/device teaches all the structural limitations of the claim – see Ex parte Masham, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Here, the structural limitations of claim 1 are disclosed by Kim (US Pat. 6,029,104). Therefore, this claim is rejected over a reference which taught all the structural limitations of the claim (the claimed functions are immaterial to the structure of claimed device and thus the claim was properly rejected).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759 (email address: cuong.nguyen@uspto.gov). The examiner can normally be reached on 9:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

/CUONG H. NGUYEN/
Primary Examiner
Art Unit 3661